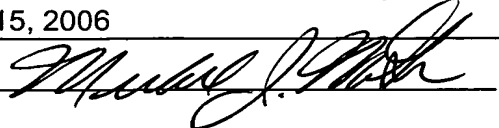
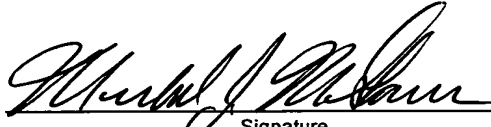


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 411076.90030	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 15, 2006</u> Signature <u></u> Typed or printed name <u>Michael J. McGovern</u>		Application Number 09/762,753	Filed March 22, 2001
		First Named Inventor Graef	
		Art Unit 2612	Examiner J. Laye
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 28,326 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u></u> Signature Michael J. McGovern Typed or printed name 414-277-5725 Telephone number May 15, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Matter No. 411076.90030

Doc. No. 5896171

I hereby certify that this correspondence is being deposited with the United States Postal Services on the date set forth below as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Signature
and Deposit:

May 15, 2006 Michael J. McInerney

Attorney of Record

PATENT

Docket No.: 411076.90030



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Graef Art Unit: 2612
Appl. No.: 09/762,753 Examiner: J. Laye
Filed: March 22, 2001
Title: RECEIVING STATION FOR SATELLITE TELEVISION
SIGNALS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Office Action of April 24, 2006, which action was made final, Applicant submits a Notice of Appeal and a Request for Pre-Appeal Review attached hereto.

The points misapprehended by the Examiner(s) are that claim 1 distinguishes over the art on the following features:

1. Providing a satellite channel converter box and tuner that can be retrofitted to existing systems having a remote control for selecting only VHF/UHF channels, for example, channels 1-100. Claim 1 recites "wherein a user can select both conventional VHF/UHF channels and satellite reception channels with one channel selection unit on the TV home receiver, or through one remote control, which include only channels of the VHF/UHF range." The Dini cited art requires the user to obtain a satellite remote control with channels 1-250 for example. No other embodiment is provided in Dini.

2. Providing a satellite channel converter box that uses a single remodulator 5 (see drawing attached) to convert satellite channel signals to VHF/UHF signals compared with the Dini which uses one remodulator (8/1 to 8/M) for each channel M available for conversion (eight to seventeen channels mean eight to seventeen remodulators in Dini for one customer). The savings in cost and efficiency of the present invention should be apparent.

Claim 1 recites: "an individual modulator, which is provided to convert the satellite television signals from any one of the receivable satellite television channels into image signals for reception by a television set on a VHF or UHF channel."

The Examiner's position on point 1 ignores the description at col. 5, lines 29-37, of Dini describing use of a satellite remote control 15 with channels 1-250.

The Examiner tries to avoid the issues in his Response to Arguments by observing on page 2 that Dini's system receives converted signals on VHF/UHF channels like the Applicant's. But that does not respond to the limitations of the claims wherein the equipment is usable with control units having only channel nos. 1-100 (VHF/UHF).

Dini uses channels in all three ranges so that a user can input satellite channel 101 or satellite channel 250. The control unit of the present invention does not allow input of satellite channels in this range; it uses only the VHF/UHF band, e.g. 1-100.

The Examiner then goes on to take official notice that the missing limitations related to point 2 above were somewhere available in the art. First, both official notice and level of skill in the art are insufficient to supply missing limitation under the law of *prima facie* obviousness (cites in Applicant's last response.) Official notice or

judicial notice is reserved for such facts as that a year includes 365 days or that water runs downhill due to gravity. The Examiner misuses the office notice concept. Applicant is prejudiced by not seeing any other art on which the Examiner is relying as such art may contain clues as to why it would not be combined as supposed by the Examiner.

MPEP 2143.03 provides that all claim limitations must be taught or suggested. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

Ma, the second reference being cited, shows a conventional Zenith TV tuner, circa 1970. It adds nothing to Dini relevant to the present invention.

Thirdly, the Examiner totally misunderstands the "black box" comments. The point is that the construction of the satellite apparatus in the present invention is different than that of the satellite apparatus in Dini and that it is retrofitted to an existing system with different results than Dini.

To assist the Examiners in reviewing this Brief, one page is hereby used to submit a copy of the revised drawings showing Fig. 1 with legends (attached).

Furthermore, the Applicant notes that the corresponding EP application has been granted and has issued as EP 1138160B1 with broader claims than herein.

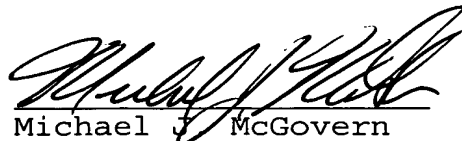
(next page)

CONCLUSION

In view of the remarks herein, a withdrawal of the final action is respectfully requested. Claims 1-4 and 7-16 are still pending and a Notice of Allowance for these claims is respectfully requested.

Respectfully submitted,

By:



Michael J. McGovern
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202
(414) 277-5725
Attorney of Record